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TO: United States Patent and Trademark Office

NAME: Ella Colbert

DATE & TIME: July 15, 2004

PAGES TO FOLLOW:

FAX NUMBER: 703-872-9306

FROM: Morris, Manning & Martin, LLP

CHARGE TO:

NAME: John R. Harris

CLIENT/MATTER: 4960-29720

PHONE: (404) 233-7000

CONFIRMATION TIME:

HR : MIN : SEC

COMMENTS:

Serial No. 09/476,385

Applicant: Tsuei et al.

Filed: December 30, 1999

Group Art Unit: 3624

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I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450, or transmitted to the U.S. Patent and Trademark Office by facsimile to number (703) 872-9306, on July 15, 2004.

John R. Harris
John R. Harris - Reg. No. 30,388

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 15 2004

In re Application of: Tsuei et al.)
Serial No. 09/476,385) Art Unit: 3624
Filed: December 30, 1999) Examiner: Colbert, Ella
For: METHOD AND SYSTEM FOR PAYMENT) CONF. NO. 7756
TRANSACTIONS AND SHIPMENT TRACKING)
OVER THE INTERNET)

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RESPONSE TO OFFICE ACTION / RESTRICTION REQUIREMENT

Commissioner for Patents
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Sir:

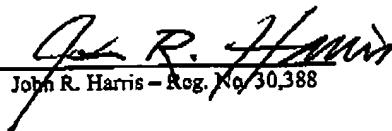
Responsive to the office action mailed June 15, 2004 containing a restriction requirement, the Applicant elects the Group I inventions, consisting of claims 46-68 and 93-117, *with traverse*.

The examiner is respectfully urged to reconsider and withdraw the restriction requirement, for the following reasons.

Claims 46-190 are generally directed to a method and system for facilitating financial transactions between a buyer and seller over a network, such as the Internet. All of the independent claims (46, 69, 93, 118, 143, and 167) are directed to steps or elements particularly applicable to a payment enabling system, within the meaning of those terms in the application (see, e.g., element 240 in FIG. 2, "payment enabler"). This is not a case involving a direct buyer/seller funds transfer, nor one that only involves a transaction

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facilitator. It is difficult to image how finding the examiner could conduct a search in this subject matter area without concentrating on art relating to payment systems, in a networked environment, involving a payment enabler operating a payment enabling system.

The examiner has apparently missed the commonality of the claims that should result in a conclusion that the claims should remain together in the same application and patent. For example, the examiner completely misses the relationship between the claim sets, which was explained in the office action response paper filed on Feb. 24, 2004. There are 6 independent claims in this case. These 6 claims are all related to payment system enablers. As will be shown, certain claims are roughly related as system and method counterparts, where the systems are computer-implemented and carry out steps that are primarily the same steps as recited in the method counterpart claims. It makes no sense to separate the method claims from a system claim that includes a computer that carries out the same steps as the method claims.

Specifically, claims 46 and 69 are related as method and system counterpart (for the most part) and have the same primary limitations, yet the examiner has separated them into Groups I and II. Similarly claims 93 and 118 are related as method and system counterpart, yet the examiner has separated these into Groups I and III. Further still, claims 143 and 167 are related roughly as method and system counterpart, but the examiner has put them into Groups II and IV. Because the method and system counterparts have many of the same method-type limitations, logically, these should be grouped together.

Where is the sense in all this? Any search on the method should produce art applicable to the system, again, since all claims are related to payment enabling systems. The reason given that these different groups have acquired separate status in the art simply doesn't make any sense. The examiner focused on Group I as the basic combination, and cites Group II as acquiring separate status in the art because it involves "payment instrument processors." Yet, a careful comparison of claim 46 in Group I with claim 69 in Group II shows that both claims involve a payment instrument processor. The examiner's own statement is, on its face, simply incorrect.

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The conclusion reached in paragraph 8, that a search for Group I is not required for Groups II, III, and IV, is simply not true. The previous examiner, a gentleman with a Ph.D., did not think to formulate such a strange division of this subject matter after three office actions. Why is it being done now? There is no good reason, except to force the applicant to incur additional fees for pursuing patents on subject matter that the Office has simply not been able to demonstrate is known in the art or should be divided into four separate patents! As mentioned above, any good search in this area -- which the previous examiner has ostensibly already conducted -- will necessarily involve systems that include a payment enabler that operates a payment enabling system.

Furthermore, searches have already been conducted by the previous examiner in this case, Dr. Akers. Interviews have already been conducted. An RCE has already been filed. For the Office to switch to a new examiner, and impose a restriction requirement at this stage, on the tenuous grounds that the subject matter has "acquired a separate status in the art" is disingenuous at best, and false. The distinctions drawn by the examiner as to "separate utility" is not well reasoned.

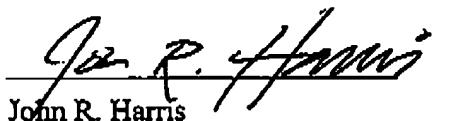
Similar observations can be made for the artificial distinctions created by the examiner in arriving at the strained conclusion that these so-called subcombinations "have separate utility." If the "separate utility" argument is taken to its logical conclusion, then no patent could ever issue with more than one independent claim -- arguably every independent claim has "separate utility" using the flawed reasoning applied by the examiner. This is not a case where there is any justification for separating these claims into this artificial grouping of four.

The Office has already delayed enough in bringing the case to a resolution. The art cited and applied in previous Office Actions is simply inapposite, and now -- a further delay with contrived reasons to separate the subject matter into four different groups (not 3, which would have been more logical) along lines that do not make any sense.

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The examiner is strongly urged to withdraw the restriction requirement and allow this patent to issue without further delay.

Respectfully submitted,


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